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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,851	07/11/2003	Mary E. Gentry	13213-048001	7990
26191	7590	06/09/2005	EXAMINER	
FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022		GREEN, BRIAN		
		ART UNIT		PAPER NUMBER
		3611		

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/617,851	GENTRY, MARY E.	
	Examiner	Art Unit	
	Brian K. Green	3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 March 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
 - 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 14-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 21 March 2005 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Election/Restrictions

Claims 1-13 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on Aug. 11, 2004 (on the phone) and March 21, 2005.

Drawings

The amendment filed March 21, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Adding the second frame portion in new figure 5 is considered to be new matter. There is no support in the original specification for showing the two frame sections attached together as shown in new figure 5. Adding the dividing element (29) in new figure 6 is considered to be new matter. There is no support in the original specification for showing the frame with a single dividing element of the shape and size shown in new figure 6.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plotkin et al. (U.S. Patent No. 5,526,597) in view of Leeland (U.S. Patent No. 1,251,791).

Plotkin et al. shows in figures 1-5 a picture frame (14) having a front side and rear side, the front side having a first viewing window (covered by glass 18) and a picture (42) and other authenticity type information secured to the rear side. Plotkin et al. does not disclose attaching a cardholder on the rear side, transcribing information on a card, and inserting the card into the cardholder. Leeland shows in figures 1-5 a cardholder (3) attached to a card, a card (the autograph card) having information written thereon, and inserting the card into the cardholder. Leeland shows in figure 1 that the cardholder includes a second viewing window. In view of the teachings of Leeland it would have been obvious to one in the art to modify Plotkin et al. by attaching a cardholder to the rear of the frame, transcribing information on the card, and inserting the card into the cardholder since this would provide additional authenticity to the displayed object and would further enhance the gift presentation and value of the display. In regard to claim 15, Plotkin discloses that the object is a photograph, see column 2, lines 65-67. In regard to claim 16, Leeland shows in figures 1-5 that the cardholder includes a mounting portion (7), an offset portion (the front portion which includes 4,5) and a cavity (the open area that receives the autograph card). In regard to claim 17, Leeland shows in figure 5 an extension (6).

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Plotkin et al. (U.S. Patent No. 5,526,597) in view of Leeland (U.S. Patent No. 1,251,791) as applied to claim 14 above and further in view of Stenger (U.S. Patent No. 3,734,155).

Plotkin et al. in view of Leeland disclose the applicant's basic inventive concept except for providing multiple cavities and cards. Stenger shows in figure 1 the use of a card holder for multiple cards. In view of the teachings of Stenger it would have been obvious to one in the art to modify Plotkin et al. by providing multiple cavities since this would allow a plurality of cards to be held by the picture frame, i.e. multiple autograph cards when multiple people are shown in the photograph.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Plotkin et al. (U.S. Patent No. 5,526,597) in view of Leeland (U.S. Patent No. 1,251,791) as applied to claim 14 above and further in view of Shevin et al. (U.S. Patent No. 4,069,606).

Plotkin et al. in view of Leeland disclose the applicant's basic inventive concept except for providing a folding card. Shevin et al. shows in figure 1 the use of a card (22) that is folded and inserted into a holder. In view of the teachings of Shevin et al. it would have been obvious to one in the art to modify Plotkin et al. by folding the card since this would allow a larger card to be used enabling more information to be placed onto the card. When the card is folded some of the information would be concealed.

Response to Arguments

Applicant's arguments filed March 21, 2005 have been fully considered but they are not persuasive.

The applicant argues that neither Plotkin et al. nor Leeland disclose that a message or greeting is transcribed on a card and inserted into a cardholder. The examiner disagrees since Leeland discloses that the card (11) contains an autograph of the person who picture is being

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displayed, i.e. the card (11) is autographed (message or greeting placed on the card) and slid into the cardholder.

The applicant argues that the Leeland reference may not be properly combined with the Plotkin et al. reference since the purpose of the Plotkin et al. device is to “permanently secure” an authenticity label 28 to the back of a framed pictorial work to authenticate the framed photo and prevent fraudulent duplications. The examiner disagrees since the addition of the cardholder and card of the Leeland patent to the frame of Plotkin would provide the advantage of increasing the authenticity to the displayed object and would further provide an enhancement to the gift presentation and value of the display.

The applicant argues that inclusion of a viewing window on a cardholder that is not in direct view under normal viewing conditions is counterintuitive and nowhere suggested by either reference. The examiner disagrees since Plotkin et al. in view of Leeland disclose all of the structure defined by the applicant in independent claim 14. Plotkin et al. teaches the idea of placing information onto the back of a picture frame and Leeland teaches that it is known to attach a cardholder having a window to a frame. The cardholder allows a card to be attached to a frame in an easier and faster manner.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (571) 272-6644. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN K. GREEN
PRIMARY EXAMINER

bkg
June 2, 2005